

## REMARKS

### I. Summary Of Office Action

Claims 1-35, 37-39, 41-44, 46, and 59-63 are pending in the above-identified patent application.

The Examiner objected to claims 28-31 and 37-39 as being dependent upon a rejected base claim.

The Examiner rejected claims 1-10, 12, 14, 25, 32-35, 59, 60, and 62\* under 35 U.S.C. § 102(b) as being anticipated by Culpepper U.S. patent No. 3,861,679 (hereinafter "Culpepper"). Claims 11, 13, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Official Notice. Claims 16-24, 26, 27, 41-44, 46, 61, and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Garver U.S. patent No. 3,529,823 (hereinafter "Garver").

### II. Summary Of Advisory Action

The Examiner maintained the objection and rejections of the Office Action, but clarified the rejection over Culpepper.

### III. Summary Of Applicants' Reply To Office Action

Applicants have amended claims 1, 3, 6-9, 12-15, and 59 to more particularly define the invention. The Examiner's objection and rejections are respectfully traversed.

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\* On pages 2 and 3 of the Office Action, the Examiner also rejected claim 17 over Culpepper. Applicants believe that this was a mistake because the Examiner on page 4 of the Office Action concedes that "Culpepper does not disclose a releasable ball," which is a feature of claim 17 (because claim 17 is dependent from claim 16) and rejects claim 17 over Culpepper in view of Garver. If applicants' belief is incorrect, the Examiner is invited to so state in the next communication.

IV. Claims 1-35, 37-39, 41-44, And 46

A. The Rejection Of Claim 1

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Culpepper. The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by claim 1, is directed towards a ball hitting practice apparatus. The apparatus comprises a first hinge that is attached at or near a first end of a substantially rigid member. Applicants have amended claim 1 to recite that the attachment is "such that said first hinge constrains said rigid member ~~rotates~~ to rotate about a substantially horizontal axis." Applicants have also amended claim 1 to recite that the hinge is secured to a support member.

In applicants' previous Reply to Office Action dated August 27, 2003, applicants argued that Culpepper fails to show or suggest a hinge that is attached at or near the first end of a substantially rigid member as specified by claim 1. The Examiner in the Advisory Action contends that "[i]tem 29 [of Culpepper] can be considered a hinge under the modified claim" and therefore claim 1 does not avoid Culpepper.

Contrary to the Examiner's contention, item 29 of Culpepper is a ring at the end of rod 13 to which the ends of springs 11 and 12 are attached. Therefore, item 29 of Culpepper is merely a means for connecting springs 11 and 12 to rod 13. Accordingly, item 29 does not function as a hinge. Therefore, item 29 of Culpepper fails to show or suggest a hinge attached at or near the first end of a substantially rigid member "such that said first hinge constrains said rigid member to rotate about a substantially horizontal axis" as specified by claim 1

Furthermore, applicants' claim 1, as amended, specifies that the hinge is also secured to a support member.

Item 29 of Culpepper, as described above, is merely used to receive the ends of springs 11 and 12. Therefore, item 29 of Culpepper fails to show or suggest a hinge that is secured to a support member as specified by claim 1.

Accordingly, at least because Culpepper fails to show or suggest a first hinge (a) attached at or near the first end of a substantially rigid member such that the first hinge constrains the rigid member to rotate about a substantially horizontal axis and (b) that is secured to a support member, claim 1 is allowable over Culpepper. Therefore, applicants request that the rejection of claim 1 be withdrawn.

B. The Rejections Of Claims 2-15,  
25-27, 32-35, 41-44, And 46

The Examiner rejected claims 2-10, 12, 14, 25, and 32-35 under 35 U.S.C. § 102(b) as being anticipated by Culpepper. Claims 11, 13, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Official Notice. Claims 26, 27, 41-44, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Garver. The Examiner's rejections are respectfully traversed.

Claims 2-15, 25-27, 32-35, 41-44, and 46 are allowable at least because independent claim 1, from which claims 2-15, 25-27, 32-35, 41-44, and 46 depend, are allowable. Accordingly, applicants request that the rejections of claims 2-15, 25-27, 32-35, 41-44, and 46 be withdrawn.

C. The Rejection Of Claims 16-24

The Examiner rejected claims 16-24 under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Garver. The Examiner's rejection is respectively traversed.

Claims 16-24 are allowable at least because independent claim 1, from which claims 16-24 depend, is allowable. Moreover, claims 16-24 are allowable for the independent reason set forth below. Applicants raised this independent reason in the previous Reply to Office Action dated August 27, 2003. The Examiner, however, did not address this independent reason in the Advisory Action. Therefore, applicants are restating the independent reason below.

Claims 16-24 all include the additional feature that the ball mounting device comprises at least one tubular member that allows for releasable mounting of a ball.

The Examiner concedes on pages 4 and 5 of the May 28, 2003 Office Action that "Culpepper does not disclose a releasable ball." In order to overcome this deficiency in Culpepper, the Examiner relies on Garver, which shows releasable mounting of a ball. The Examiner, however, has failed to provide the requisite motivation necessary to present a rejection under 35 U.S.C. § 103(a).

In the "Response to Arguments" section of the May 28, 2003 Office Action, the Examiner's comments suggest that there was a misunderstanding of applicants' previous arguments.\* Applicants did not argue that Culpepper himself was not aware of a releasable ball. Rather, applicants argued that Culpepper teaches away from using a release ball. Therefore, even though a person skilled in the art may be aware of a releasable ball, it would not be obvious for that person to apply the releasable ball to Culpepper because Culpepper teaches away from using a releasable ball.

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\* See applicants' April 21, 2003 Reply to Office Action, page 5.

The purpose of Culpepper's invention is to "result in a desirably smooth and rapid return of the ball to the stroking position" (column 1, lines 65-68). Culpepper improves on prior devices in which "the operator must physically return the ball to the stroking position" (column 1, lines 28 and 29). In addition, Culpepper states that the prior devices "are not adaptable to continuous usage without change of operator position" (column 1, lines 30 and 31). If the releasable ball of Garver were to be employed with the apparatus of Culpepper, the ball would be released from the apparatus when stroked by the user. This would defeat the purpose of Culpepper's invention. Therefore, Culpepper teaches a person skilled in the art not to use a releasable ball.

The Examiner contends it would have been obvious to employ "the ball of Garver with the apparatus of Culpepper in order to make the game more enjoyable to play" (May 28, 2003 Office Action, page 4). The Examiner's contention is respectfully traversed. First, as demonstrated above, Culpepper teaches away from such a combination. Second, Culpepper's apparatus is not used for playing a game. Rather, Culpepper's apparatus is used for "practicing and learning the fundamentals of the game of tennis" (abstract of Culpepper).

Third, there is nothing in Culpepper, Garver, or the knowledge generally available to a person skilled in the art to suggest that using a releasable ball with the apparatus of Culpepper would make Culpepper's apparatus more enjoyable. Applicants respectfully submit that the Examiner has failed to fulfill the requirement of presenting an "objective teaching ... or ... knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references" In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Accordingly, because the Examiner has failed to provide the requisite motivation to combine Garver with Culpepper, and because Culpepper teaches away from such a combination, claims 16-24 are allowable for this independent reason.

In view of the foregoing, applicants request that the rejection of claims 16-24 be withdrawn.

D. Objection To Claims 28-31 And 37-39

The Examiner objected to claims 28-31 and 37-39 as being dependent upon a rejected base claim. Applicants note with appreciation the indication of allowable subject matter in claims 28-31 and 37-39, and hereby expressly reserve the right to rewrite those claims in independent form should the base claims not ultimately be allowed.

In view of the foregoing, independent claim 1, from which claims 28-31 and 37-39 depend, is allowable, and therefore claims 28-31 and 37-39 are allowable. Accordingly, applicants request that the objection to claims 28-31 and 37-39 be withdrawn.

V. Claims 59-63

A. The Rejection Of Claim 59

The Examiner rejected claim 59 under 35 U.S.C. § 102(b) as being anticipated by Culpepper. The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by claim 59, is directed towards a ball hitting practice apparatus. The apparatus comprises a hinge secured to a horizontal support structure. The hinge is also attached at or near an upper end of a substantially rigid member. Applicants have amended claim 59 to recite that the attachment is "such that said hinge

constrains said lower portion [of the rigid member] ~~rotates to~~ rotate about a substantially horizontal axis."

The Examiner in the Advisory Action also contends that claim 59 does not avoid Culpepper because "[i]tem 29 [of Culpepper] can be considered a hinge under the modified claim." However, as demonstrated above, item 29 of Culpepper fails to show or suggest a hinge (a) attached to a substantially rigid member such that the hinge constrains the rigid member to rotate about a substantially horizontal axis and (b) that is secured to a support member.

Accordingly, Culpepper, including item 29, fails to show or suggest a hinge (a) attached at or near an upper end of a substantially rigid member such that the hinge constrains the lower portion of the rigid member to rotate about a substantially horizontal axis and (b) secured to a horizontal support structure as specified by claim 59. Therefore, applicants request that the rejection of claim 59 be withdrawn.

B. The Rejections of Claims 60-63

The Examiner rejected claims 60 and 62 under 35 U.S.C. § 102(b) as being anticipated by Culpepper. Claims 61 and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Garver. The Examiner's rejections are respectfully traversed.

Claims 60-63 are allowable at least because independent claim 59, from which claims 60-63 depend, are allowable. Accordingly, applicants request that the rejections of claims 60-63 be withdrawn.

VI. Conclusion

In view of the foregoing, claims 1-35, 37-39, 41-44, 46 and 59-63 are in condition for allowance. This application

is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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